



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/346,063

07/01/1999

KENT J. SIEFFERT

10792/004001

1973

21186

7590

11/14/2006

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.  
P.O. BOX 2938  
MINNEAPOLIS, MN 55402

EXAMINER

NGUYEN, NGA B

ART UNIT

PAPER NUMBER

3692

DATE MAILED: 11/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/346,063

Applicant(s)

SIEFFERT ET AL.

Examiner

Nga B. Nguyen

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 May 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2,4,5 and 7-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 2,4,5 and 7-23 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This Office Action is in response to the response to Election/Restriction filed on May 2, 2006, which paper has been placed of record in the file.
2. Claims 2, 4, 5, and 7-23 are pending in this application.

### ***Response to Election/Restriction***

3. Applicant's response to Election/Restriction with respect to claims 2, 4, 5, and 7-23 have been considered but are moot in view of new grounds Restriction.

### ***Election/Restriction***

4. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 2, 4, 9, and 17-23 drawn to a method facilitating transfer of intellectual property asset via global computer network, classified in class 705, subclass 37.
  - II. Claims 7, 8, 15, and 16 drawn to a method for facilitating transfer of intellectual property assets in which first and second intellectual property asset are combined into an intellectual property asset package, classified in class 705, subclass 26.
  - III. Claims 5 and 10-14 drawn to a method facilitating transfer of intellectual property asset in which access to the asset identifier and the terms of transfer limiting as a function of an access profile associated with each network user, classified in class 726, subclass 29.
5. The inventions are distinct, each from the other because of the following reasons:

Inventions are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown

to be separately usable. See MPEP § 806.05(d). In the instant case, invention has separate utility such as:

Inventions I and II have separate utility such as: the invention I drawn to a method facilitating transfer of intellectual property asset via global computer network, in contrast, the invention II drawn to a method for facilitating transfer of intellectual property assets in which first and second intellectual property asset are combined into an intellectual property asset package. Therefore, the invention I and II are shown to be separately usable.

Inventions I and III have separate utility such as: the invention I drawn to a method facilitating transfer of intellectual property asset via global computer network, in contrast, the invention III drawn to a method facilitating transfer of intellectual property asset in which access to the asset identifier and the terms of transfer limiting as a function of an access profile associated with each network user. Therefore, the invention I and III are shown to be separately usable.

Inventions II and III have separate utility such as: the invention II drawn a method for facilitating transfer of intellectual property assets in which first and second intellectual property asset are combined into an intellectual property asset package, in contrast, the invention III drawn to a method facilitating transfer of intellectual property asset in which access to the asset identifier and the terms of transfer limiting as a function of an access profile associated with each network user. Therefore, the invention II and III are shown to be separately usable.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Art Unit: 3628

7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen whose telephone number is (571-272-6796. The examiner can normally be reached on Monday-Thursday from 9:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on (571) 272-6799.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-3600.

9. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

C/o Technology Center 3600

Washington, DC 20231

Or faxed to:


(703) 872-9306 (for formal communication intended for entry),

or

(571) 273-0325 (for informal or draft communication, please label "PROPOSED" or "DRAFT").

Art Unit: 3628

Hand-delivered responses should be brought to Knox building, 501 Dulany Street, Alexandria, VA, First Floor (Receptionist).

  
NGA NGUYEN  
PRIMARY EXAMINER

July 20, 2006